

## REMARKS

With regard to the request in the Office Action to update the Cross Reference to Related Applications, no changes have occurred. The immediately preceding application remains pending.

The rejected claims 50 – 55 recite a host with two circuit card receptacles, a first receptacle that receives memory that includes a controller of the operation of the memory and a second receptacle for a memory card without such a controller. A memory controller is also built into the host and connected with the second receptacle. The host can therefore operate with a raw memory card connected with the second receptacle, by using the host's built-in controller, or with a memory that is provided with its own controller, which uses the first receptacle. Claims 50 – 52 are more specific by including a two-card structure, a first ("mother") card containing the controller that connects with the first host receptacle and a second ("daughter") card containing the memory that connects with the host either through the mother card or directly to the host's second receptacle. Either way, the memory card is connected with the host in a manner that provides a controller function that operates the memory and interfaces it with the host. An example of such a host and cards is described with respect to Figure 10 of the present application.

Reconsideration of the rejection of claims 50 and 52 – 54 under 35 U.S.C. § 103(a) over U.S. patent no. 4,882,702 ("Struger et al.") is respectfully requested in light of the amendments being made to claim 53 and these remarks. The Office Action appears to assert that the expansion module 20 and one of the connected expansion racks 26 or 27 of Struger et al. correspond to the first (mother) card of claims 50 – 52, having controllers 50 and 51, and that one of the I/O modules 13 corresponds to the claimed second (daughter) card, apparently because a module 13 can be plugged into either a slot of the rack 11 directly or into one of the expansion racks 26 or 27. The electronic host of claims 53 – 55 is therefore apparently found, in the view of Struger et al. expressed in the Office Action, by a slot of the rack 11 that directly receives a module 13 corresponding to the claimed second card receptacle and a slot of the rack 11 that receives the expansion module corresponding to the claimed first card receptacle.

But it is respectfully submitted that this does not anticipate or render the claims obvious. For one reason, this most favorable view of Struger et al. in support the rejection does not suggest placement of the claimed controller function in the manner claimed. The rejected claims

specify that one host receptacle is provided with the controller function and the other is not. If a memory system is inserted into the receptacle without a host supplied controller, the controller function is included as part of the external memory system.

It is respectfully submitted that there is no suggestion in Struger et al. for a card controller to alternatively be placed either within the host and connected to one of the card receptacles, or external to the host when another of the card receptacles absent the controller function is used. In Struger et al., the processor module 10 within the rack 11 is connected with all the modules 13, whether inserted directly into the rack 11 or into the expansion racks 26 and 27. The expansion module 20, to which the expansion racks 26 and 27 are connected, does contain additional controllers 50 and 51 but these are in addition to the controller 10, not in place of it. For modules 13 inserted into the expansion racks 26 and 27, all of the controllers 10, 50 and 51 are used, and for modules 13 inserted directly into the rack 11, only the controller 10 is used. No suggestion has been found in Struger et al. for the controllers 50 and 51 to replace the controller 10 to operate a module inserted into an expansion rack 26 or 27.

There is therefore no suggestion by Struger et al. for the host to provide the controller function for one card receptacle but not for another card receptacle, as is claimed. The claims specify that a memory system inserted into one receptacle need not include the controller function, since the host provides it, but the memory system inserted into the other receptacle is provided with the controller function in order to operate with the host in the same way. This is simply not suggested by Struger et al.

As a second primary distinction from Struger et al., the controller function of the claims is recited to control operation of the memory of an inserted card while the controllers 10, 50 and 51 only facilitate communication between the backplane 12 and the modules 13. Claims 50 – 52 specify that the “controller function” is “operable to control a memory,” and claims 53 – 55 include “a controller function to operate the memory.” There is no such function stated in Struger et al. for the communication controllers 10, 50 and 51 referenced in the Office Action.

The second reference cited in the Office Action along with Struger et al. in an obviousness rejection of dependent claims 51 and 55, namely US patent no. 5,682,548 (“Moore”), was not cited for the two primary controller features of the claims that are discussed above and indeed is not seen to be pertinent to either of them. It is therefore respectfully

submitted that neither of the cited references described the combinations of the rejected claims 50 – 55, either alone or in combination.

New claims 56 – 62 being added by this amendment are dependent upon either of the independent claims 50 or 53, so are believed patentable for the reasons given above for those claims. In addition, other novel features are added by these claims. New claim 59 specifies that the memory is “semiconductor memory,” and claim 56 recites that the memory is “semiconductor flash memory”. The cited references do not suggest use of such a memory. New claims 57, 60 and 61 call for the host receptacles to have different configurations to mate with cards of different sizes. New claim 58 adds that the first and second connectors receive only one of the first and second cards of claim 53 and not the other. These features are also contrary to Struger et al., where the modules 13 and the connectors to which they are attached are all the same. Lastly, claim 62 specifies card dimensional constraints that are believed to be novel over the cited references.

#### Information Disclosure Statement

A Supplemental Information Disclosure Statement is being filed herewith to make of record two patents that are discussed in the primary Struger et al. patent reference.

#### Conclusion

Accordingly, it is believed that this application is now in condition for allowance and an early indication of its allowance is solicited. However, if the Examiner has any further matters that need to be resolved, a telephone call to the undersigned attorney at 415-318-1163 would be appreciated.

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